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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,096	07/25/2001	Lily C. Li	31021.P004	5562

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EXAMINER

GOLD, AVI M

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,096

Applicant(s)

OHSAKI ET AL.

Examiner

Avi Gold

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the amendment filed on July 7, 2005. Claims 1-45 are pending.

Response to Amendment

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Pollack, U.S. Patent No. 6,505,236.

Pollack teaches the invention as claimed including a system and method which detaches and stores any mail attachments and appends the body of the mail to include a handle to enable the recipient to retrieve the stored attachment at a later time (see abstract).

Regarding claim 1, Pollack teaches a method comprising:

receiving a request to send an email (col. 4, lines 4-6, Pollack discloses a receiving portal to receive an email);

determining whether the email to be sent includes one or more attachments (col. 1, lines 59-62, Pollack discloses multiple attachments on an email);

determining whether a recipient of the email has distributed storage separate from an incoming email server of the recipient for storing email attachments, if the email to be sent includes one or more attachments (col. 4, lines 25-34, Pollack discloses a mail attachment storage system);

determining a network address of the recipient's distributed storage for storing email attachments, if the recipient has such distributed storage (col. 4, lines 34-39, Pollack discloses a storage device that stores attachment at specific address);

determining whether the recipient's distributed storage is available to receive the one or more attachments upon determining the network address (col. 6, lines 39-48, Pollack discloses the use of an attachment comparator to see if an attachment can be received and kept); and

servicing said request to send said email based at least in part on the results of said determinations (col. 7, lines 1-11, Pollack discloses an email sent without an attachment).

Regarding claims 2 and 14, Pollack teaches the method of claims 1 and 13, wherein said determining of whether the recipient of the email has distributed storage separate from an incoming email server of the recipient for storing email attachments comprises querying a recipient email distributed storage location server (col. 4, lines 25-34).

Regarding claim 3 and 15, Pollack teaches the method of claims 1 and 13, wherein said determining of the network address of the recipient's distributed storage for storing email attachments comprises querying a recipient email distributed storage location server (col. 4, lines 25-39).

Regarding claim 4 and 16, Pollack teaches the method of claims 1 and 13, wherein said determining of whether the recipient's distributed storage is available to receive the one or more attachments comprises pinging the recipient's email distributed storage using said determined network address (col. 4, lines 25-39, col. 6, lines 39-48).

Regarding claim 5 and 29, Pollack teaches the method and apparatus of claims 1 and 28, wherein said determination results based servicing comprises sending a main body of the email to the incoming email server of the recipient, and sending the one or more attachments of the email to the recipient's distributed storage for storing email attachments, if the recipient has distributed storage for storing email attachments, and the distributed storage is available to accept said one or more attachments (col. 7, lines 1-11).

Regarding claim 6 and 30, Pollack teaches the method and apparatus of claims 1 and 28, wherein said determination results based servicing comprises sending a main body of the email to the incoming email server of the recipient, and sending an instruction to the recipient's distributed storage to submit a request for the one or more

attachments of the email, if the recipient has distributed storage for storing email attachments, and the distributed storage is available to accept said one or more attachments (col. 5, lines 50-67, col. 7, lines 1-11, Pollack discloses an attachment receiver).

Regarding claim 7, 18, and 31, Pollack teaches method and apparatus of claims 1, 17, and 30, wherein the method further comprises sending the one or more attachments of the email to the recipient's distributed storage for email attachments upon receipt of a request from the recipient's distributed storage for the one or more attachments of the email (col. 4, lines 25-39).

Regarding claim 8 and 32, Pollack teaches the method and apparatus of claims 1 and 28, wherein said determination results based servicing comprises sending a main body of the email to the incoming email server of the recipient, and retrying to send the one or more attachments of the email to the recipient's distributed storage in accordance with a retry policy, if the recipient has distributed storage and the distributed storage is not immediately available to accept said one or more attachments (col. 6, lines 39-48).

Regarding claim 9 and 33, Pollack teaches the method and apparatus of claims 1 and 28, wherein said determination results based servicing comprises sending a main body of the email and the one or more attachments of the email to the incoming email

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server of the recipient if the recipient has distributed storage and the distributed storage is not available to accept said one or more attachments (col. 1, lines 35-45, col. 2, lines 26-57, Pollack discloses an attachment attached directly to an email if no storage is available).

Regarding claim 10 and 34, Pollack teaches the method and apparatus of claims 1 and 28, wherein said determination results based servicing comprises sending a main body of the email and the one or more attachments of the email to the incoming email server of the recipient if the recipient does not have distributed storage for email attachments (col. 1, lines 35-45, col. 2, lines 26-57).

Regarding claim 11, Pollack teaches the method of claim 1, wherein said method further comprises repeating said determining and determination results based servicing operations for each recipient of the email (col. 7, lines 1-11).

Regarding claim 12, Pollack teaches the method of claim 11, wherein said method further comprises determining recipients of the email, including determining members of a recipient group (col. 7, lines 1-11).

Regarding claim 13, Pollack teaches a method comprising:
receiving an email on behalf of a recipient, the email including a main body and one or more attachments (col. 1, lines 59-62, col. 4, lines 4-6);

determining whether the recipient of the email has distributed storage for storing email attachments (col. 4, lines 25-34);

determining a network address of the recipient's distributed storage for storing email attachments, if the recipient has such distributed storage (col. 4, lines 34-39);

determining periodically whether the recipient's distributed storage is available to receive the one or more attachments upon determining the network address (col. 6, lines 39-48); and

sending the one or more attachments of the email to the recipient's distributed storage for email attachments for storage, upon determining that the recipient's distributed storage for email attachments is available to accept email attachments (col. 4, lines 35-39).

Regarding claim 17, Pollack teaches the method of claim 13, wherein said sending of the one or more attachments of the email to the recipient's distributed storage for email attachments comprises sending an instruction to the recipient's distributed storage to submit a request for the one or more attachments of the email (col. 5, lines 50-67, col. 7, lines 1-11).

Regarding claim 19, Pollack teaches a method comprising:

receiving a registration to register an email user's distributed storage for email attachments (col. 4, lines 25-39);

storing a network address of the email user's distributed storage for email attachments (col. 4, lines 34-39);

receiving a request from a requestor for the network address of the email user's distributed storage for email attachments; and

providing the requestor with the network address of the email user's distributed storage for email attachments (col. 5, lines 50-67, col. 7, lines 1-11).

Regarding claim 20, Pollack teaches the method of claim 19, wherein the requestor is a selected one of a sender of an email and an incoming email server of a recipient of an email (col. 5, lines 50-67, col. 7, lines 1-11).

Regarding claim 21, Pollack teaches a method comprising:

receiving a request from a selected one of a sender and an incoming email server of a user to pull an attachment of an email;

in response, submitting a request to the selected one of the sender and the incoming email server of the user to pull said email attachment;

receiving said email attachment; and

storing said email attachment (col. 5, lines 50-67, col. 7, lines 1-11).

Regarding claim 22 and 40, Pollack teaches the method and apparatus of claims 21 and 39, wherein the method further comprises

receiving a request from a requestor for the email attachment;

retrieving the email attachment from storage; and
providing the retrieved email attachment to the requestor upon successfully
retrieving said email attachment from storage (col. 5, lines 50-67, col. 7, lines 1-11).

Regarding claim 23, Pollack teaches a method comprising:
receiving a request from a user to access an attachment of an email;
determining whether a distributed storage for storing email attachments for the
user is accessible;
determining whether the attachment is stored in said distributed storage if said
distributed storage is accessible; and
servicing said request to access said attachment of said email based at least in
part on the result of said determination (col. 5, lines 50-67, col. 7, lines 1-11).

Regarding claim 24 and 42, Pollack teaches the method and apparatus of claims
23 and 41, wherein said determining of whether the user's distributed storage for email
attachments is accessible comprises pinging the user's distributed storage for email
attachments (col. 4, lines 25-39, col. 6, lines 39-48).

Regarding claim 25 and 43, Pollack teaches the method and apparatus of claims
23 and 41, wherein said determination results based servicing comprises retrieving the
attachment from the user's distributed storage for storing email attachments if the user's

distributed storage for storing email attachments is accessible, and the attachment is stored in the user's distributed storage for storing email attachments (col. 7, lines 1-11).

Regarding claim 26 and 44, Pollack teaches the method and apparatus of claims 23 and 41, wherein said determination results based servicing comprises retrieving the attachment from an incoming email server of the user if the user's distributed storage for storing email attachments is accessible, and the attachment is not stored in the user's distributed storage for storing email attachments (col. 1, lines 35-45, col. 2, lines 26-57).

Regarding claim 27 and 45, Pollack teaches the method and apparatus of claims 23 and 41, wherein said determination results based servicing comprises attempting to retrieve the attachment from an incoming email server of the user if the user's distributed storage for storing email attachments is not accessible (col. 1, lines 35-45, col. 2, lines 26-57).

Regarding claim 28, Pollack teaches an apparatus comprising:
storage medium having stored therein a plurality of programming instructions designed to enable said apparatus to
receive a request to send an email (col. 4, lines 4-6),
determine whether the email to be sent includes one or more attachments (col. 1, lines 59-62),

determine whether a recipient of the email has distributed storage separate from an incoming email server of the recipient for storing email attachments, if the email to be sent includes one or more attachments (col. 4, lines 25-34),

determine a network address of the recipient's distributed storage for storing email attachments, if the recipient has such distributed storage (col. 4, lines 34-39),

determine whether the recipient's distributed storage is available to receive the one or more attachments upon determining the network address (col. 6, lines 39-48), and

service said request to send said email based at least in part on the results of said determinations (col. 7, lines 1-11); and

a processor coupled to the storage medium to execute the programming instructions (col. 7, lines 35-51, Pollack discloses a processor performing the process).

Regarding claim 35, Pollack teaches an apparatus comprising:

storage medium having stored therein a plurality of programming instructions designed to enable said apparatus to

receive an email on behalf of a recipient, the email including a main body and one or more attachments (col. 1, lines 59-62, col. 4, lines 4-6),

determine whether the recipient of the email has distributed storage for storing email attachments (col. 4, lines 25-34),

determine a network address of the recipient's distributed storage for storing email attachments, if the recipient has such distributed storage (col. 4, lines 34-39),

determine periodically whether the recipient's distributed storage is available to receive the one or more attachments upon determining the network address (col. 6, lines 39-48), and

send the one or more attachments of the email to the recipient's distributed storage for email attachments for storage, upon determining that the recipient's distributed storage for email attachments is available to accept email attachments (col. 4, lines 35-39); and

a processor coupled to the storage medium to execute the programming instructions (col. 7, lines 35-51).

Regarding claim 36, Pollack teaches the apparatus of claim 35, wherein said programming instructions are designed to enable the apparatus to send an instruction to the recipient's distributed storage for email attachments, instructing the recipient's distributed storage for email attachments to submit a request for the one or more attachments of the email (col. 5, lines 50-67, col. 7, lines 1-11).

Regarding claim 37, Pollack teaches the apparatus of claim 36, wherein said programming instructions are further designed to enable the apparatus to send the one or more attachments of the email to the recipient's distributed storage for email attachments upon receipt of a request from the recipient's distributed storage for the one or more attachments of the email (col. 4, lines 25-39).

Regarding claim 38, Pollack teaches an apparatus comprising:

- storage medium having stored therein a plurality of programming instructions designed to enable said apparatus to
 - receive a registration to register an email user's distributed storage for email attachments (col. 4, lines 25-39),
 - store a network address of the email user's distributed storage for email attachments (col. 4, lines 34-39),
 - receive a request from a requestor for the network address of the email user's distributed storage for email attachments, and
 - provide the requestor with the network address of the email user's distributed storage for email attachments (col. 5, lines 50-67, col. 7, lines 1-11); and
- a processor coupled to the storage medium to execute the programming instructions (col. 7, lines 35-51).

Regarding claim 39, Pollack teaches an apparatus comprising:

- storage medium having stored therein a plurality of programming instructions designed to enable said apparatus to
 - receive a request from a selected one of a sender and an incoming email server of a user to pull an attachment of an email,
 - submit, in response, a request to the selected one of the sender and the incoming email server of the user to pull said email attachment,
 - receive said email attachment, and

store said email attachment (col. 5, lines 50-67, col. 7, lines 1-11); and
a processor coupled to the storage medium to execute the programming
instructions (col. 7, lines 35-51).

Regarding claim 41, Pollack teaches an apparatus comprising:
storage medium having stored therein a plurality of programming instructions
designed to enable said apparatus to
receive a request from a user to access an attachment of an email,
determine whether a distributed storage for storing email attachments for the
user is accessible,
determine whether the attachment is stored in said distributed storage if said
distributed storage is accessible, and
service said request to access said attachment of said email based at least in
part on the result of said determination (col. 5, lines 50-67, col. 7, lines 1-11); and
a processor coupled to the storage medium to execute the programming
instructions (col. 7, lines 35-51).

Response to Arguments

3. Applicant's arguments filed July 7, 2005 have been fully considered but they are not persuasive.

Regarding the argument to claim 1, the applicant argues that the reference, Pollack, does not disclose receiving a request to send an email, storage separate from

an incoming email server for attachments, and servicing a request to send email based at least in part on the results of determinations. The examiner disagrees, as seen in, col. 4, lines 4-6, it is inherent that a sender would request to send the email; col.4, lines 25-34, a mail attachment storage system is explicit that it is separate storage; and col. 7, lines 1-11, based on *at least in part* of the determinations the email is sent without the attachment.

Regarding the argument to claim 19, the applicant argues that the reference, Pollack, does not disclose the email user's distributed storage being registered. The examiner disagrees, as seen in, columns 1-3; it is inherent that the storage system would need to be registered.

Regarding the argument to claim 21, the applicant argues that the reference, Pollack, does not disclose receiving a request from a selected one of a sender and an incoming email server. The examiner disagrees, as seen in, col. 5, lines 50-67 and col. 7, lines 1-11, there is receiving a request from a recipient to download a stored attachment and receiving from a sender an electronic mail item which contains a forwarding specification and an attachment; both of which display inherency for the claimed limitation.

Regarding the argument to claim 38, the applicant argues that the reference, Pollack, does not disclose a plurality of programming instruction. The examiner disagrees, as seen in, col. 4, lines 25-39, there is a storage device which inherently would have programming instructions in order to operate properly.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 5,903,723 to Beck et al.

U.S. Pat. No. 6,839,741 to Tsai

U.S. Pat. No. 6,651,087 to Dennis

U.S. Pat. No. 5,771,355 to Kuzma

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 571-272-4002. The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold

Patent Examiner

Art Unit 2157

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